

### **REMARKS**

Claim 1 has been amended to specify that the disc is for use on an orbital sander with a plurality of exhaust ports and that at least two perforations of the disc are in register with each exhaust port on an orbital sander. Support for these amendments is found throughout the originally filed specification, including at page 1, lines 4 and 5, and at page 2, lines 24-27.

New Claim 8 has been added. Support for this claim can be found throughout the originally filed specification, including at page 2, lines 12-27.

No new matter has been added.

#### **Rejection of Claims 1-7 under 35 U.S.C. § 103(a)**

In the Office Action of March 20, 2003, Claims 1-7 were rejected under 35 U.S.C. § 103(a). Specifically, the Examiner rejected Claims 1-5 and 7 as being unpatentable over U.S. Patent 5,810,650, issued to Jöst. Claim 5 was rejected as being unpatentable over Jöst in view of Gutknecht, et al.

In that Office Action, the Examiner stated that Jöst disclosed an abrasive disk for use with a suction-type apertured backup pad comprising a plurality of uniformly spaced perforations, at least some of which overlie the apertures in the backup pad to allow the pad to be placed randomly on the backup pad while still allowing suction passageways to remain open to draw dust through the pad. The Examiner also stated that the distribution of the perforations across the disk taught by Jöst does not appear to be critical and only perforations which lie within the annular region bounded by the pad apertures would be capable of delivering dust through the apertures, thus any holes located outside of this annular region are non-functional with respect to suction capability, and thus the particular range of holes would have been an obvious matter of design choice to those of ordinary skill in the art. The Examiner cited *In re Nelson*, 95 U.S.P.Q. 82 (C.C.P.A. 1952), for the proposition that the removal of a structure with a consequent loss of that structure's function is considered an obvious matter of design choice. The Examiner stated that the removal of non-functional suction apertures lying outside of an area encompassed by the suction passageways would have been no more than an obvious matter of design choice.

Also in that Office Action, the Examiner stated that Gutknecht, et al. disclose the alternative use of hook-and-loop or adhesive fastening of an abrasive disk to a backup pad. The

Examiner believes that the use of a conventional hook-and-loop type or adhesive fastening means for temporary removal or repositioning of the disk on the backup pad would have been obvious in view of Gutknecht, et al.

During the August 8, 2003 telephonic conference, Applicant noted that the elimination of the non-functional apertures of Jöst is not a "removal," as characterized by Examiner, but is instead a replacement of previously non-abrasive apertures with additional abrasive surface area. As such, Applicant noted that the proposition cited from *Nelson* does not apply in this instance and removing the non-functional apertures is not obvious.

Also during that telephonic conference, Applicant noted at least six additional characteristics of Applicant's claimed invention which Jöst does not teach or suggest, including:

1. an annular zone,
2. an annular zone that is a radial distance from the center of the disk from of one-third to one-half of the radius of the disk,
3. an annular zone that is a radial distance from the circumference of the disk from one quarter to one third the radius of the disk,
4. perforations exclusively within an annular zone, each having a diameter less than one quarter the width of the annular zone
5. perforations that are essentially uniformly spaced in an annular zone, and
6. perforations in an annular zone with a distance between any pair of adjacent perforations is less than twice the greatest dimension of either perforation.

While not agreeing with the Examiner's rejection and solely to speed prosecution, Applicant has amended Claim 1 to recite that at least two perforations are in register with each exhaust port on an orbital sander. Neither reference teaches or suggests, separately or in combination, a disk with at least two perforations in register with each exhaust port on an orbital sander. Claims 2-7 include this amendment because they are dependent from Claim 1. Newly added Claim 8 includes similar language.

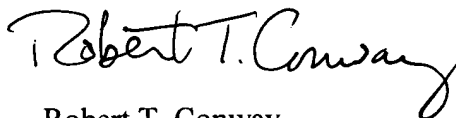
In view of this amendment, Applicant respectfully asserts that the claimed invention meets the requirements of 35 U.S.C. § 103.

CONCLUSION

Claim 1 has been amended and new Claim 8 has been added. In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner believes that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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